

It was previously held that claims sharing common subject matter which merely provide additional limitations to perfect the basic inventive concept are therefore so interwoven as to constitute a single invention to be examined together. See, In re Application of Leber, Decision on Petition, filed July 20, 1987, Serial No. 902,864, published in PRI opinions on December 3, 1990; a copy of which was previously sent to the Examiner. In the present case, Claims 1-10 and 21-24 of the present application share common subject matter related to the analysis of a sample to determine the susceptibility of the sample to antimicrobial materials by the methods set forth in Claims 1 (which method provides at least two growth indicator values, each representing a respective growth characteristic of the sample) and 21 (which method provides for determining at least one MIC value for a sample). This can be found in the independent Claims 1 and 21 and all claims dependent thereon.

Applicants further respectfully submit that Groups I and III should be examined together, since they are both classified in Class 435, and all the claims in Groups I and III are directed to method claims related to the analysis of a sample contained in at least one well. Thus, Applicants respectfully submit that all of Claims 1-10 and 21-24 share common subject matter, and Applicants respectfully request that the present restriction requirement be withdrawn.

It should also be observed that a requirement for restriction is not mandatory under either 35 U.S.C. §121 or 37 C.F.R. §1.142, it is merely discretionary. This observation is particularly important in light of court decisions which have indicated that an improperly made restriction requirement would not preclude a holding of double patenting, despite the language of 35 U.S.C. §121, third sentence. Eversharp, Inc. v. Phillip Morris, Inc., 256 F. Supp. 778, 150 USPQ 98 (E.D. Va. 1966), aff'd, 374 F. 2d 511, 153 USPQ 91 (4th Cir. 1967). In addition, the courts have recognized the advantages to the public interest to permit a patentee to claim all aspects of its invention, as the Applicants have done herein, so as to encourage the patentee to make a more detailed disclosure of all aspects of its discovery. The CCPA has observed:

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in a manner required by 35 U.S.C. §113 all aspects of what they regard as their invention; regardless of the number of statutory classes involved. In re Kuehl, 177 USPQ 250, 256 (CCPA 1973). (Emphasis added).

Furthermore, Applicants respectfully suggest that in view of the continued increases of official fees and the potential limitation of an applicant's financial resources, a practice which arbitrarily imposes restriction requirements may become

prohibitive and thereby contravene the constitutional intent to promote and encourage the progress of science and the useful arts.

Thus, it is again respectfully urged that the Examiner reconsider and withdraw the requirement for restriction and provide an action on the merits with respect to Claims 1-10 and 21-24.

The Examiner has alleged that the present title of the application "is not aptly descriptive." Applicant have provided a new title that Applicants respectfully submit is clearly indicative of the claimed invention.

The Examiner has rejected Claims 1-10 as allegedly rendered obvious under 35 USC Section 103(a) by the combination of Clark in view of Wertz.

In order to advance prosecution and further clarify the subject matter of the present invention, Applicants have amended Claim 1 and incorporated the subject matter of Claims 2 and 3 into Claim 1. Accordingly, Applicants have cancelled Claims 2 and 3.

The claimed invention in main Claim 1, as amended, is directed to a method for analyzing a microbiological sample contained in at least one sample well, comprising the steps of: directing a plurality of different analyzing light wavelengths onto said microbiological sample contained in said sample well; detecting a respective resultant light wavelength emanating from said microbiological sample for each of said analyzing light wavelengths directed onto said microbiological sample; generating a result value representative of each respective resultant light wavelength; and mathematically combining said result values to provide at least two growth indicator values, each representing a respective growth characteristic of said microbiological sample, wherein at least one of said growth indicator values represent a redox state of said microbiological sample, and wherein another of said growth indicator values represents a turbidity value of said microbiological sample.

The combination of Clark and Wertz does not teach or suggest the claimed invention as amended. Therefore, withdrawal of the instant rejection is respectfully requested.

Thus in view of the above Amendment and Remarks, it is believed that the present application is in condition for allowance, which action is earnestly solicited.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Bruce S. Weintraub", with a stylized flourish at the end.

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VERSION WITH MARKINGS TO SHOW CHANGES MADE.

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IN THE CLAIMS:

Claim 1 has been amended as follows.

Claim 1. A method for analyzing a microbiological sample contained in at least one sample well, comprising the steps of:

directing a plurality of different analyzing light wavelengths onto said microbiological sample contained in said sample well;

detecting a respective resultant light wavelength emanating from said microbiological sample for each of said analyzing light wavelengths directed onto said microbiological sample;

generating a result value representative of each respective resultant light wavelength; and

mathematically combining said result values to provide at least two growth indicator values, each representing a respective growth characteristic of said microbiological sample, wherein at least one of said growth indicator values represents a redox state of said microbiological sample, and wherein another of said growth indicator values represents a turbidity value of said microbiological sample.